



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,026	12/17/2001	Tsuneyuki Kikuchi	15167	2382

23389 7590 03/10/2005

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

EXAMINER

COULTER, KENNETH R

ART UNIT PAPER NUMBER

2141

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,026

Applicant(s)

KIKUCHI, TSUNEYUKI

Examiner

Kenneth R Coulter

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/8/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claims 5 and 9 – 19 are objected to because of the following informalities:

“A terminal device in accordance with **claims** 1, wherein ...” (claim 5, line 1);

Appropriate correction is required.

“with **one of** claim” (claim 9, line 1; claim 10, line 1; claim 11, line 1; claim 12, line 1; claim 13, line 1; claim 14, line 1; claim 15, line 1; claim 16, line 1).

2. Claims 18 and 19 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 18 and 19 have not been further treated on the merits.

Drawings

3. Figure 19 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1 - 17 and 20 - 23 are rejected under 35 U.S.C. 102(e) as being disclosed by Kariya (U.S. Pat. No. 6,169,897) (Mobile Communications System and Mobile Terminal Therefor with Capabilities to Access Local Information Resources).

5.1 Regarding claim 1, Kariya discloses a terminal device coupled via a communication line to Internet connection service providing means for browsing via an Internet network a content server having stored contents therein, comprising:

content requesting means for issuing a content request to request a content selected by a user according to a content menu disposed for the user to select a desired content (Abstract; Fig. 2);

counting means for counting a number of requests of a content requested by said content requesting means (col. 7, line 66 – col. 8, line 17 “incrementing its ‘hits per hour’”); and

Art Unit: 2141

notifying means for notifying information of a content of which the number of requests satisfies a predetermined notification condition, the information being added to the content request (col. 7, line 66 – col. 8, line 17).

5.2 Per claim 2, Kariya teaches a terminal device coupled via a communication line to Internet connection service providing means for browsing via an Internet network a content server having stored contents therein, comprising:

content requesting means for issuing a content request to request a content selected by a user according to a content menu disposed for the user to select a desired content (Abstract; Fig. 2);

counting means for counting a number of requests of a content requested by said content requesting means (col. 7, line 66 – col. 8, line 17 “incrementing its ‘hits per hour’”); and

notifying means for notifying information of a content of which the number of requests satisfies a predetermined notification condition, the information being added to the content request the counting means comprises:

storage means for storing therein the number of requests for each address of a content server in which the content selected by the user is stored (col. 7, line 66 – col. 8, line 17); and adding means for adding the number of requests of the content for each request for the content (col. 7, line 66 – col. 8, line 17),

or

Art Unit: 2141

the counting means comprises: storage means for storing therein an address of said content server in which the content selected by the user is stored and a day and time of the selection (col. 7, line 66 – col. 8, line 37); and totaling means for conducting a retrieval through said storage means and for totaling the number of requests for each content within a predetermined period of time (col. 7, line 66 – col. 8, line 37).

5.3 Regarding claim 3, the rejection of claim 1 under 35 USC 102(e) (paragraph 5.1 above) applies fully.

In addition, Kariya discloses wireless communication means to be coupled with said communication line via wireless communication (Abstract "mobile communications system which provides a **mobile subscriber** with local information"; Fig. 1).

5.4 Per claim 4, the rejection of claims 1 – 3 under 35 USC 102(e) (paragraphs 5.1 – 5.3 above) applies fully.

5.5 Regarding claim 5, Kariya discloses a terminal device in accordance with claims 1, wherein said content requesting means comprises means for receiving and storing the content menu therein (Abstract; Figs. 2, 4, 5).

5.6 Per claims 6 - 17 and 20 – 23, the rejection of claims 1 – 5 under 35 USC 102(e) (paragraphs 5.1 – 5.5 above) applies fully.

Art Unit: 2141

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

krc

KENNETH R. COULTER
PRIMARY EXAMINER
